

REMARKS/ARGUMENTS

35 USC §102 (b)

Reconsideration and allowance are requested of Claims 1-3 and 5 which the Examiner has rejected under 35 USC §102(b) as being anticipated by Pullen. Rejection of claims based upon anticipation requires that all of the elements and limitations of each claim must be found within a single prior art reference. Carella v. Starlight Archery and Pro Line Co., 804 F.2d 135, 138, 231 USPQ 644, 646 (Fed.Cir.1986). *There must be no difference between the claimed invention and the reference disclosure*, as viewed by a person of ordinary skill in the field of the invention. Scripps Clinic & Research Foundation v. Genentech, Inc., 927 F.2d 1565, 1576 (C.A. Fed. 1991).

MPEP § 706.02(b) states that a 35 USC § 102(b) rejection can be overcome by persuasively arguing that the claims are patentably distinguishable from the prior art reference, and/or by amending the claims to patentably distinguish over the prior art. Applicant contends that Claims 1-3 and 5, as now amended, patentably differ from the Pullen reference for the following reasons.

First of all, Pullen does not disclose a double spool or reel assembly. The tape in Pullen is wound around the single reel 34 (with no gear on its axis) with additional components being motor driven gears on axes separate from the axis of the reel 34. There is no secondary spool wound with a spring. Applicant's claims clearly recite a primary spool and a first gear turnable together about the primary axis, i.e., the *same* axis. Applicant's claims then recite a secondary spool and a second gear turnable

together about the secondary axis, i.e., the *same* axis. Thus, the primary spool (containing the tape wound around it) is turnable together with the first gear, and the secondary spool (containing the spring wound around it) is turnable together with second gear. Since the first and second gears are connected by an endless flexible member, when the tape is extended by the user, the spring is wound and when the tape is released, the spring will cause retraction of the tape. In Pullen, the reel or spool is driven by a motor 20 which powers both the extension and retraction of the tape through the gear train 21 which drives pressure rollers 48 and 46, the latter one of which directly engages the tape 12 that is wound on the reel 34. This clearly is an entirely different structure than that disclosed and claimed by Applicant. To be operable, Pullen requires a battery-driven motor 20, three gears 22, 24 and 26 and two pressure rollers 46 and 48. The only additional teaching of Pullen in its Fig. 5 is that there is a drive belt 53 (driven by motor 20 through a series of gears and pulleys) that directly engages the tape 12 to extend and retract the tape. The only function of the spring 54 of Fig. 5 (and spring 40 of Fig. 4) is to bias a pressure roller against the reel 34 – it does not function like the wound spring 19 in Applicant's tape measure, which spring serves to retract the tape. There is not even a suggestion of the simple structure of Applicant's tape measure as set forth in Claim 1. As stated above and recited in the claims, the driving structure of Applicant's device is a spring wound on the secondary spool that winds up when the tape is extended and unwinds when the tape is released to retract the tape through the two gears (one on each spool) that are interconnected by the belt 28.

35 USC §103

The Examiner has rejected Claim 4 under 35 U.S.C. §103 as unpatentable over Pullen, and has rejected Claims 6, 8 and 9 as unpatentable over Pullen in view of Lin. Claims 4, 6, 8 and 9 are submitted as being nonobvious and thus patentable over these references for all the reasons set forth above with reference to the rejection of Claim 1. The Pullen teachings are for a tape measure that is entirely different structurally and functionally, requiring a battery-driven motor, a gear train, pulleys, pressure rollers and in Fig. 5 a belt to both extend and retract the tape. There is not even a suggestion of Applicant's double-spool structure with the tape wound on one and the spring on the other, the spool being interconnected by a flexible member that is wound around gears, one on the same axis as one spool and the other on the same axis as the other spool. This simple structure provides a smooth operating extendable tape measure that has a minimum number to components which contributes to its maintenance and trouble-free operation and low cost. The cited patent to Lin teaches only (and is cited by Examiner only for) a tape blade lock that extends outside one of the sides of the tape housing and is operable by the user. Adding this lock to Pullen would not function in the manner of either Lin or Applicant, and in fact would interfere with the operation of Pullen's device. Pullen is powered by a motor, and thus the tape only moves when the motor is driven in one direction or the other to extend or retract the tape. No lock is necessary in

Pullen, and the Examiner does not show, nor does Lin or Pullen teach, how the lock could be combined with Pullen to function at all. Unless there is some suggestion or motivation in one of the references that the combination can be made, the law is clear that the combination is not proper. See, In Re Sang-Su-Lee, 277 F.3rd 1338, 61 USPQ 2d 1430 (Fed. Cir. 2002); Heidelberger Druckmaschinen AG v. Hantscho Commercial Products Inc., 21 F.3d 1068 (Fed. Cir. 1994). These cases, as well as other earlier cases cited therein, unanimously hold that the motivation to combine features of prior art references cannot come from the invention itself but must be *suggested by the prior art*. See, Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561 (Fed. Cir. 1987); In Re Geiger, 815 F.2d 687 (Fed. Cir. 1987); Alco Standard Corp. v. Tennessee Valley Auth., 808 F.2d 1490 (Fed. Cir. 1986). In determining whether a person of ordinary skill would have been led to this combination of references, it is improper simply to use that which the inventor taught against its teacher. W. L. Gore v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983).

Conclusion


Applicant has amended the only independent claim, Claim 1, to clarify the structure of Applicant's tape measure which distinguishes it from the prior art. It is respectfully submitted that this response places the claims of Applicant's application in condition for allowance, and therefore further and favorable action on this application is requested. If for any reason the Examiner has any questions about the amended claims or the statements made in this response, Applicant's attorney respectfully

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requests the Examiner to contact Applicant's attorney by telephone to set up an interview. It is believed that such an interview would be helpful in placing the application in condition for allowance if the Examiner is not already convinced by the amendments and arguments presented in this paper.

Respectfully submitted,

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